

U.S. Serial No. 10/092,088
Attorney Docket No. P-022-RC1
Page 5 of 6

III. REMARKS

Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

1. Status of the Claims

Claims 72-81 are currently pending for examination on the merits in this application.

2. Summary of the Amendments

Claim 72 has been amended to incorporate the specific values recited for R¹⁵, R²¹, R²², R²³, R²⁴, R²⁵, n, x Y and Z into the chemical structure of formula II. As a result, the previous definitions for R¹⁵, R²¹, R²², R²³, R²⁴, R²⁵, n, x Y and Z found in Claim 72 have been deleted. Additionally, in view of the amendment to Claim 72 in which "Z" has been replaced with "H", Claims 77 and 78 have been amended to replace the phrase "R^b and Z form" with "-R^b-H is."

These amendments are being made entirely for cosmetic reasons and are not being made to satisfy any requirement for patentability. Entry of these amendments is respectfully requested.

3. Obviousness-Type Double Patenting

Claim 72 has been rejected under the judicially-created doctrine of obviousness-type double patenting in view of Claim 1 of U.S. Patent No. 6,444,786 B1; or Claim 6 of U.S. Patent No. 6,620,781 B2. In response, Applicants are submitting herewith terminal disclaimers in compliance with 37 C.F.R. §1.321(c). Accordingly, these rejections may be withdrawn.

Applicants note that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Specifically, the courts have indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

4. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 72-81 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter

U.S. Serial No. 10/092,088
Attorney Docket No. P-022-RC1
Page 6 of 6

which Applicants regard as the invention. Specifically, the Examiner has indicated that, in Claim 72, R^{22} , R^{23} , R^{24} and R^{25} can only represent one substituent and not a variable, and therefore, the Examiner has indicated that the structure should be amended to show the specific values for these substituents.

In response, Applicants first note for the record that the present claims meet the requirements of 35 U.S.C. §112, second paragraph, because there is absolutely no ambiguity or uncertainty about what is being claimed in Claim 72 as present presented. However, in order to expedite the allowance of this application, Applicants have amended the chemical structure of formula II in Claim 72 to incorporate the specific values for R^{15} , R^{21} , R^{22} , R^{23} , R^{24} , R^{25} , n , x Y and Z . Accordingly, this objection may be withdrawn.

5. Conclusion

Reconsideration of this application in view of the above amendments and remarks is respectfully requested. Should there be any issues regarding this application that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned attorney at (650) 808-6406.

Respectfully submitted,
THERAVANCE, INC.

Date: January 4, 2005

By:


Jeffrey A. Hagena, Ph.D., Esq.
Reg. No. 35,175

THERAVANCE, INC.
901 Gateway Blvd.
South San Francisco, CA 94080
(650) 808-6000
(650) 808-6078 (Fax)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER: _____**

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.